



US MAY 2006

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

09 MAY 2006

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Stephen A. Bent  
Foley and Lardner, LLP  
3000 K Street, NW  
Suite 500  
Washington, DC 20007

In re Application of :  
JACKSON, et al. :  
PCT No.: PCT/IB03/04177 : DECISION ON PETITION  
Application No.: 10/522,777 :  
Int. Filing Date: 18 August 2003 : UNDER 37 CFR 1.47(a)  
Priority Date: 16 August 2002 :  
Atty. Docket No.: 027524-0122 :  
For: INHIBITION OF PHSPHOINOSTIDE :  
3-DINASE BETA :  
:

This decision is in response to applicant's "Petition Under 37 CFR §1.47(a)" filed 23 January 2006 in the United States Patent and Trademark Office (USPTO).

**BACKGROUND**

On 18 August 2003, applicant filed international application PCT/IB03/04177, which claimed priority of an earlier application filed 16 August 2002. A copy of the International Application was forwarded to the United States Patent and Trademark Office (USPTO) from the International Bureau (IB) on 26 February 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 February 2005.

On 31 January 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an application data sheet and a First Preliminary Amendment. An executed oath or declaration was not included.

On 20 July 2005, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 23 January 2006, applicant responded with the present petition to accept the combined declaration and power of attorney without the signature of joint inventor Vijaya Kenche

accompanied by a declaration executed by the remaining joint inventors on their own behalf and on the behalf of the non-signing joint inventor. The petition was also accompanied by a petition for a five-month extension of time and payment of the appropriate petition fee.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. With the filing of the present petition and accompanying papers, applicant has satisfied items 1-3.

As to item (4), applicant has a combined declaration and power of attorney executed by the remaining joint inventors on their own behalf and on the behalf of the non-signing joint inventor. However, the filed declaration does not comply with 37 CFR 1.497 (a)-(b). The Manual of Patent Examining Procedure (MPEP) Section 201.03 states, in part:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

As to the presently filed declaration, the document contains three pages "page 4 of 6" and four pages "page 5 of 6." This suggests that the declaration was assembled from numerous declarations or that the signing inventors returned only their signature pages. Either version renders the declaration non-compliant.

### **CONCLUSION**

For the reasons above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED without prejudice.**

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3294  
Fax: (571) 273-0459